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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,373	03/30/2001	Sarita Chauhan	BC1032 US NA	7359

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/823,373

Applicant(s)

CHAUHAN ET AL.

Examiner

Jeffrey Fredman

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1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, 9-20, 23, 46, drawn to nucleic acids, classified in class 536, subclass 22.1.
  - II. Claims 6-8, drawn to proteins, classified in class 530, subclass 350.
  - III. Claims 21 and 22, drawn to methods of making nucleic acids, classified in class 435, subclass 6.
  - IV. Claims 24-42, drawn to methods of converting carboxylic acids, classified in class 558, subclass 311.
  - V. Claims 43-44, drawn to methods of making mutants, classified in class 435, subclass 440.
  - VI. Claim 45, drawn to a mutated microbial gene, classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions in Group I and in Groups II and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the nucleic acids of Group I are chemically and structurally distinct from the proteins of Group II and are chemically and structurally distinct from the mutated genes of Group VI. These compounds each have different modes of operation, with the

nucleic acids functioning in hybridization and expression assays and the proteins to enzymatically function. Further, these compounds have different functions, with the mutant microbial gene differing in function from the wildtype nucleic acids and the protein differing in function from both.

3. Inventions in Group I and in Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group I can be made by the synthetic method of Group III or by chemical synthesis on an oligonucleotide synthesizer.
4. Inventions in Group I and in Groups IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acid of Group I can be used in methods of converting carboxylic acids, in making mutants, in PCR methods, in hybridization detection methods or in methods of purification of nucleic acids.
5. Inventions in Group II and in Groups III, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §

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806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the protein is not capable of use with the method of making nucleic acids, methods of making mutants or mutated microbial genes. Further, the protein has different modes of operation than any of these groups, with enzymatic function while the methods of making nucleic acids or mutants and mutated microbial genes lack such function.

6. Inventions in Group II and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the protein of Group II can be used in the conversion method of Group IV, and can be used in production of antibodies, in methods of immunoassay or in purification columns

7. Inventions in Groups III, IV and V are each unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions differ in mode of operation, function and effect with the Group III method operating by nucleic acid techniques to function to identify nucleic acids to result in a cloned nucleic acid. Alternatively, the Group IV conversion method operates by enzymatic or chemical techniques to convert chemicals to result in converted antibiotics. Lastly, the Group V method operates by mutagenesis techniques to alter nucleic acids to result in mutated nucleic acids.

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8. Inventions in Group V and in Group VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group VI can be made by the method of Group V or by chemical synthesis on an oligonucleotide synthesizer.

9. In order to be perfectly clear, the following subgroups within the particular Groups are NOT species elections. These are independent and distinct because the nucleic acids are composed of nucleotides and function in , e.g., methods of nucleic acid hybridization or amplification. These groups are directed to different combinations of nucleic acids which are different from one another and may be employed in different methods.

If any Group is elected, further election from the following restriction subgroup is required.

Restriction Subgroup I - SEQ ID NO: 1

Restriction Subgroup II - SEQ ID NO: 2

Restriction Subgroup III - SEQ ID NO: 3

Restriction Subgroup IV - SEQ ID NO: 4

Restriction Subgroup V - SEQ ID NO: 5

Restriction Subgroup VI - SEQ ID NO: 6

Restriction Subgroup VII - SEQ ID NO: 7

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Restriction Subgroup VIII - SEQ ID NO: 8

Restriction Subgroup IX - SEQ ID NO: 9

Restriction Subgroup X - SEQ ID NO: 10

Restriction Subgroup XI - SEQ ID NO: 11

Restriction Subgroup XII - SEQ ID NO: 12

Restriction Subgroup XIII - SEQ ID NO: 13

Restriction Subgroup XIV - SEQ ID NO: 14

Restriction Subgroup XV - SEQ ID NO: 15

Restriction Subgroup XVI - SEQ ID NO: 16

If any Group is selected, further election of from the following Restriction subgroup is required.

Restriction Subgroup A – ATCC-PTA1175

Restriction Subgroup B – ATCC PTA 1176

Restriction Subgroup C – ATCC PTA 1177

Restriction Subgroup D – SS1002 with Pnitex2

Restriction Subgroup E – SS1011 with Pnitex2

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

11. A telephone call was made to Linda Floyd on June 3, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is 703-308-6568. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman  
Primary Examiner  
Art Unit 1637

June 3, 2002